

The opinion in support of the decision being entered today is
not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES KEVIN GILLIE

Appeal 2007-3551
Application 10/803,360
Technology Center 1700

Decided: September 11, 2007

Before BRADLEY R. GARRIS, CATHERINE Q. TIMM, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1-24. Claims 25-48 have been withdrawn from examination by the Examiner and, therefore, are not involved in this appeal. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and REMAND.

I. BACKGROUND

The invention relates to a printable, coated, biaxially oriented film.

Claim 1 is illustrative:

1. A printable, coated, biaxially oriented film, comprising:

(a) a polymeric base film having a predominant polymer, and a first and a second side, said predominant polymer being polypropylene; and

(b) a urethane coating on said first side, said coating having been applied to said base film between a machine direction orientation and a transverse direction orientation of a two step tentering operation.

The Examiner relies on the following prior art references to show unpatentability:

Posey	US 4,525,419	Jun. 25, 1985
Kinoshita	US 5,824,394	Oct. 20, 1998

Specifically, the Examiner rejects claim 1-24 under 35 U.S.C. § 103(a) as being unpatentable over Kinoshita in view of Posey.

II. DISCUSSION

The issue on appeal arising from the contentions of Appellant and the Examiner is: Has the Examiner properly established a prima facie case of obviousness within the meaning of 35 U.S.C. § 103(a)? We answer this question in the negative.

Kinoshita is directed to a biaxially oriented laminated *polyester* film with improved adhesiveness (col. 2, ll. 24-26). To accomplish the improved adhesiveness, Kinoshita coats the polyester film with an acrylic- or urethane-

based adhesive (col. 2, ll. 33-43). Kinoshita explains that, in prior art polyester films having undercoat layers, there was a problem of poor adhesion between the undercoat layer and the polyester base film due to poor compatibility (col. 1, l. 19 to col. 2, l. 15). Kinoshita solves the adhesion problem “by use of a polyester film having a specific construction.” (col. 2, ll. 17-21). Specifically Kinoshita selects a specific co-extrusion laminated multilayer polyester film with a layer contacting the coating (the A layer) having specific crystalline properties (col. 2, ll. 33-43).

The Examiner recognizes that the Kinoshita polyester film contacting the coating does not contain polypropylene as claimed. It is the position of the Examiner that Posey discloses a printable laminate where the oriented base film may be made of polyester or polypropylene, those compositions thus being equivalent, and, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed the polypropylene film, as taught by Posey, as the base film in Kinoshita (Answer 4).

The evidence does not support the position of the Examiner. This is because Kinoshita teaches the use of a polyester base layer with specific properties so that it is compatible with the urethane or acrylic coating to be applied, and the Examiner has not established that one of ordinary skill in the art would understand the polypropylene of Posey as having the necessary properties for obtaining the desired adhesion to the acrylic or urethane coating. The base layer of Posey is coated with a chemically different coating, i.e., a copolyester primer coating. Equivalency of the two polymer compositions is not established.

The examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). This burden has not been met in this case.

Issues for Further Consideration

Prior to an allowance, we direct the Examiner to U.S. Patent 6,217,687 B1, a patent to Shibata et al. issued April 17, 2001. The Examiner should analyze whether the appealed claims are patentable over Shibata alone or in combination with other prior art.

Shibata describes treating a surface of a film by “subjecting the film surface to successive oxidation and coating treatments and stretching said coated film, followed by second oxidation and coating treatments, to thereby obtain a treated film which has satisfactory ink transferability and adhesion thereto and long-term stability and shows excellent printability.” (col. 1, ll. 7-14). The treated thermoplastic resin of the film may be a polypropylene resin (col. 4, ll. 47-67 and especially col. 4, ll. 52 and 61-67). The treated thermoplastic resin film may be a stretched film (col. 6, ll. 30-32), and, specifically, may be a uniaxially stretched polyolefin resin film (col. 6, ll. 61-67).¹ The applied coating may be a urethane coating (col. 7, ll. 66-67). The stretching occurring after coating may be a transverse-direction stretching (col. 12, ll. 36-37). The object is to provide a thermoplastic film having antistatic properties and water resistance that allows satisfactory transfer and adhesion of ultraviolet-curing inks to its surface even after storage in high-temperature, high-humidity atmosphere (col. 2, ll. 52-56).

¹ Polypropylene is a type of polyolefin.

In summary, Shibata suggests forming a printable, coated, biaxially oriented film having a polypropylene base film coated with a urethane coating, the urethane coating applied after a uniaxial stretching step, but before a transverse stretching step as required by claim 1.

We remand to the Examiner to allow the Examiner to consider the patentability of the claims of record in view of Shibata and any other prior art that is relevant.

III. CONCLUSION

In summary, we determine that the Examiner has not properly established a prima facie case of obviousness within the meaning of 35 U.S.C § 103(a) over Kinoshita in view of Posey. We further determine that new evidence, namely Shibata, calls into question the patentability of the claims.

IV. DECISION

The decision of the Examiner is reversed and the Application remanded to the Examiner to allow consideration of new evidence (U.S. Patent 6,217,687 B1 issued to Shibata et al.).

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center involved, for appropriate action in view of the above comments.

This application, by virtue of its “special” status, requires immediate action.

REVERSED and REMANDED

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